

REMARKS

In the Office Action¹, the Examiner objected to Applicants' claim for priority; rejected claims 1, 5-7, and 30-33 under 35 U.S.C. §112, first paragraph; rejected claims 1, 5-7, and 30-33 under 35 U.S.C. §112, second paragraph; rejected claims 1, 5, 30, and 32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,347,136 to Horan ("*Horan*") in view of U.S. Patent No. 6,198,915 to McGregor et al. ("*McGregor*"); and rejected claims 1, 6, 7, 31, and 33² under 35 U.S.C. § 103(a) as being unpatentable over *Horan*, *McGregor*, and further in view of U.S. Patent No. 5,956,697 to Usui ("*Usui*").

Applicants have amended claims 1 and 30, and claims 1, 5-7, and 30-33 remain pending.

Regarding the objection to Applicants' claim for priority, Applicants submit that the priority documents were filed in this application, and Applicants attach a date stamped postcard acknowledging receipt of the priority documents. Therefore, Applicants respectfully request that the Examiner withdraw the objection.

Regarding the rejection of claims 1, 5-7, and 30-33 under 35 U.S.C. §112, first paragraph, the Examiner states that the claimed "computing means for computing . . . a weighting factor that is unique to each of the plurality of functions . . ." is not found in Applicants' specification" (Office Action at page 3).

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

² Applicants note that the Examiner included claim 1 in the list of rejected claims, but did not address claim 1. Therefore, Applicants will only address the rejection of dependent claims 6, 7, 31, and 33.

In response, Applicants direct the Examiner's attention to the specification at page 33, line 9 - page 34, line 23. Applicants submit that at least this part of the specification provides support for the claimed subject matter. Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 5-7, and 30-33 under 35 U.S.C. §112, first paragraph.

Regarding the rejection of claims 1, 5-7, and 30-33 under 35 U.S.C. §112, second paragraph, the Examiner states that Applicants have not identified "particular structures or steps within the disclosure as the means for or steps for that Applicants' intend to claim" (Office Action at page 3).

Claim 1 recites an "apparatus" that includes an "operation inputting means," a "function executing means," a "measuring means," a "computing means," and a "receiving means."

The structure for performing the "operation inputting means" is key operation part 33. According to the specification, "[t]he microcomputer part 31 determines which function key has been operated given an input operation by the user on the key operation part 33. With the operated function key recognized, the microcomputer part 31 controls the function executing part 32 accordingly" (See page 35, lines 20-24 and Fig. 10).

The structure for performing the "function executing means" is function executing part 32 (See page 34, line 24 - page 36, line 3 and Fig. 10). Applicants also direct the Examiner's attention to the flowchart in Fig. 11 which provide additional support for the claimed "function executing means."

The structure for performing the “measuring means” is controlling part 351.

According to the specification, “the controlling part 351 in the charge processing part 35 ascertains that a specific function corresponding to the function key in question is being selectively executed. By referring to time information from the clock part 352, the controlling part 351 measures an execution time of the function in question, i.e., the time in which the function is being used. On the basis of the used time thus measured, the controlling part 351 computes a chargeable time in the manner described earlier. The computed chargeable time is stored into the memory 353” (See page 36, lines 5-15 and Fig. 10). Applicants also direct the Examiner’s attention to the flowchart in Fig. 11 which provide additional support for the claimed “measuring means.”

The structure for performing the “computing means” is controlling part 351.

According to the specification, “the controlling part 351 in the charge processing part 35 computes a chargeable time ” (See page 38, lines 10-19 and Fig. 10). Applicants also direct the Examiner’s attention to the flowchart in Fig. 11 which provide additional support for the claimed “computing means.”

The structure for performing the “receiving means” is charge processing part 35.

According to the specification, “[t]he user 1 pays the fee by settling the charge in a predetermined manner. At the vender 2, the charge management system 5 verifies the payment of the fee. If the charge is not settled by the settlement date, the charge management system 5 transmits to the electronic apparatus 3 a key that disables functions of the apparatus. Upon receipt of the disabling key, the electronic apparatus 3 has its functions turned off partially or as a whole. If the charge management system 5 has later confirmed the payment of the fee by the user 1, the system 5 sends to the

electronic apparatus 3 a key that enables the functions of the apparatus" (See page 17, line 13 - page 18, line 1). The specification also states, "[i]f the controlling part 351 judges the time limit for settlement to have been exceeded, the charge processing part 35 requests the microcomputer part 31 to disable the electronic apparatus 30 partially or totally. In turn, the electronic apparatus 30 has its functions totally deactivated or partially restricted (in step S116)" (See page 49, lines 8-14). Applicants also direct the Examiner's attention to the flowchart in Fig. 18 which provide additional support for the claimed "receiving means."

Dependent claim 5-7 also recite a "storing means," "transmitting means," and "settling means."

The structure for performing the "storing means" is memory 353 (See page 35, line 13 - page 36, line 12 and Fig. 10). Applicants also direct the Examiner's attention to the flowchart in Fig. 11 which provide additional support for the claimed "storing means."

The structure for performing the "transmitting means" is charge processing part 35 (See page 35, line 13 - page 36, line 12 and Fig. 10). Applicants also direct the Examiner's attention to the flowchart in Fig. 11 which provide additional support for the claimed "transmitting means."

The structure for performing the "settling means" is charge processing part 35 (See page 35, line 13 - page 36, line 12 and Fig. 10). Applicants also direct the Examiner's attention to the flowchart in Fig. 11 which provide additional support for the claimed "settling means."

Independent claim 30 recites an “apparatus” that includes a “first receiving means,” “execution used time measuring means,” “chargeable time computing means,” “storing means,” and “second receiving means.”

The structure for performing the “first receiving means” is charge processing part 35 (See page 35, line 13 - page 36, line 12 and Fig. 10). Applicants also direct the Examiner’s attention to the flowchart in Fig. 11 which provide additional support for the claimed “first receiving means.”

The structure for performing the “execution used time measuring means” is controlling part 351 (See page 38, lines 10-19 and Fig. 10). Applicants also direct the Examiner’s attention to the flowchart in Fig. 11 which provide additional support for the claimed “execution used time measuring means.”

The structure for performing the “chargeable time computing means” is controlling part 351 (See page 38, lines 10-19 and Fig. 10). Applicants also direct the Examiner’s attention to the flowchart in Fig. 11 which provide additional support for the claimed “chargeable time computing means.”

The structure for performing the “storing means” is memory 353 (See page 35, line 13 - page 36, line 12 and Fig. 10). Applicants also direct the Examiner’s attention to the flowchart in Fig. 11 which provide additional support for the claimed “storing means.”

The structure for performing the “second receiving means” is charge processing part 35 (See page 35, line 13 - page 36, line 12 and Fig. 10). Applicants also direct the Examiner’s attention to the flowchart in Fig. 11 which provide additional support for the claimed “second receiving means.”

Dependent claim 31 also recites a “transmitting means.” The structure for performing the “transmitting means” is charge processing part 35 (See page 35, line 13 - page 36, line 12 and Fig. 10). Applicants also direct the Examiner’s attention to the flowchart in Fig. 11 which provide additional support for the claimed “transmitting means.”

Regarding the Examiner’s additional comments, Applicants have amended claim 1 to insert “measured” and replaced “used” with “execution” in claim 30 as requested by the Examiner. The Examiner also states, “[i]t is unclear and vague which at least one of the plurality of functions is being referred to and which ‘each of the functions has been executed.’ Do Applicants’ mean each of the functions of playback, recording, fast forwarding, and rewinding?” (Office Action at pages 4-5). In response, Applicants submit that the “plurality of functions” do refer to “playback, recording, fast forwarding, and rewinding.” Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 5-7, and 30-33 under 35 U.S.C. §112, second paragraph.

Applicants respectfully traverse the rejection of claims 1, 5-7, and 30-33 under 35 U.S.C. § 103(a).

Claim 1 recites an electronic apparatus including, for example:

...
measuring means for measuring the time during which each of the plurality of functions has been executed;

computing means for computing an amount of charge by multiplying the measured execution time of each of the plurality of functions by a weighing factor that is unique to each of the plurality of functions, wherein a time unit charge decreases as the measured execution time increases and the time unit charge becomes zero when the measured execution time reaches a predetermined time value; and

receiving means for receiving a first key to disable at least one of the plurality of functions if the amount of charge is not settled, and a second key to enable at least one of the plurality of functions if the amount of charge is settled.

(Emphasis added).

Horan discloses a caller identification method. Display/control logic 158

“includes control inputs (e.g. play, record, fast forward, rewind, pause, stop, keypad, arrows, etc.) for controlling answering machine functions, entering names and phone numbers, setting preferences, etc.” (col. 3, lines 52-55). These inputs are not used in computing charge based on an “execution time” of each input. *Horan* is silent regarding any type of charging means. Even though *Horan* discloses control inputs, these inputs are used for entering names, controlling an answering machine, etc. They are not used by any “computing means for computing an amount of charge based on the execution time” of the control inputs.

The Examiner correctly states that *Horan* does not teach or suggest the claimed “measuring means,” “computing means,” and “receiving means” (Office Action at page 6). *McGregor* does not cure the deficiencies of *Horan*.

McGregor discloses mobile debit phone units “where real time calculation[s] of phone charges is necessary to limit phone use or to immediately bill for phone use” (col. 2, lines 27-30). A mobile phone unit 30 “can internally maintain a user’s call account, at least within a rental period or within a period of periodic polling by the central processing unit 14 during off hours” (col. 4, lines 46-50 and Fig. 1). Mobile phone unit 30, when functioning as a debit phone, can continue to operate until the account is exhausted (col. 4, lines 52-53).

The phone system in *McGregor* does not teach or suggest measuring the time that a “plurality of functions” are executed. Therefore, *McGregor* does not teach or suggest the claimed “measuring means for measuring the time during which each of the plurality of functions has been executed,” as recited in claim 1.

In addition, the general debit scheme in *McGregor* fails to multiply a “measured execution time of each of the plurality of functions by a weighing factor that is unique to each of the plurality of functions.” Moreover, the debit scheme in *McGregor* also fails to teach or suggest a “time unit charge” that “decreases as the measured execution time increases and the time unit charge becomes zero when the measured execution time reaches a predetermined time value,” as further recited in claim 1.

Furthermore, while *McGregor* mentions call restrictions (col. 10, lines 30-56), these restrictions enable “a service provider to disable segments of the numbers or whole numbers right at the source” (col. 10, lines 32-33). This restriction does not teach or suggest the claimed combination of a “first key” and a “second key.” Therefore, *McGregor* does not teach or suggest the claimed combination of elements including, for example, a “receiving means for receiving a first key to disable at least one of the plurality of functions if the amount of charge is not settled, and a second key to enable at least one of the plurality of functions if the amount of charge is settled,” as further recited in claim 1.

In addition, the Examiner has not established the requisite motivation necessary to combine *McGregor* and *Horan*. The Federal Circuit has noted that “virtually all [inventions] are combinations of old elements.” See e.g., *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (internal citations omitted). The Federal

Circuit has explained that an Examiner may find every element of a claimed invention in the prior art, but mere identification is not sufficient to negate patentability. *Id.* The court explained that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.*

Also, determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001), 59 USPQ2d 1693, 1696-98 (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). The desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. See *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002), 61 USPQ2d 1430, 1433 (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52). Additionally, the Federal Circuit has clearly stated that the evidence of a motivation or suggestion to modify a reference must be “clear and particular.” *In re Dembicziak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In this case, the Office Action does not show that a skilled artisan considering *McGregor* and *Horan*, and not having the benefit of Applicants’ disclosure, would have been motivated to combine the references in a manner resulting in Applicants’ claimed combination. The Examiner merely provided descriptions of how the references allegedly teach certain features without providing “clear and particular” reasons why a skilled artisan “would select the elements from the cited prior art references for

combination in the manner claimed.” See *In re Dembicziak*, 175 F.3d at 999, 50 USPQ2d at 1617; *In re Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1457.

The Examiner has alleged no motivation for combining *McGregor* and *Horan*, and no motivation exists. For example, *McGregor* calculates phone charge “to limit use or to immediately bill for phone use” (col. 2, lines 29-30). *McGregor* charges based on the duration and location of the phone call. One of ordinary skill would recognize that functions, such as playback, recording, fast forwarding, and rewinding are not associated with the phone charges in *McGregor*. Moreover, *McGregor* provides no motivation, explicit or implicit, for charging for functions other than talking for a duration of time.

In addition, *Horan* provides no teaching of computing charges. Any control input in *Horan* is used, for example, to listen to messages or organize an address book. Such actions are not associated with phone charges. The fact that both *McGregor* and *Horan* are related to telephone use does not provide the needed motivation to combine the two references.

Accordingly, *Horan* and *McGregor* fail to establish a *prima facie* case of obviousness with respect to claim 1. Claim 5 are also allowable at least due to its depending from claim 1. Independent claims 30 and 32, although of different scope than claim 1, are allowable for at least the same reasons discussed above in regard to claim 1.

Although the Examiner cites *Usui* in the rejection of dependent claims 6, 7, 31, and 33, Applicants respectfully assert that *Usui* fails to cure the deficiencies of *Horan*

and *McGregor* discussed above. Therefore, claims 6, 7, 31, and 33 are also allowable at least due to their dependence from claims 1, 30, and 32, respectively.

In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: April 17, 2009

By: /David W. Hill/
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Serial No. _____ File No. 50100-03077 By WSF/s
Title In the Matter of the Application of Satoru Suzuki et al.
The following due 3/24 in the U.S. Patent Office, was received in the Patent Office
☐ Affidavit ☐ Declaration ☒ Express Mail Mailing Certificate
☐ Amendment ☐ (separate sheet) 14682 for \$ 2324-
☐ Preliminary Amendment ☒ Check No. 14682 for \$ 2324-
☐ Amendment After Final Rejection ☐ Deposit Account Order Form
☐ Request for Extension of Time ☒ Drawing 47 Sheet(s)
☐ Provisional Patent Application ☐ Information Disclosure Statement
☒ Application for Patent, including ☐ PTO Form 1449
114 Pages Specification 43 Claims ☐ Issue Fee Transmittal
☒ Declaration ☒ Power ☐ Brief ☒ Letter
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☐ Assignment ☐ Recordation Cover Sheet ☒ Fee Transmittal Sheet

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☐ Affidavit ☐ Declaration ☒ Express Mail Mailing Certificate
☐ Amendment ☐ (separate sheet) 14682 for \$ 2324-
☒ Preliminary Amendment 971 U.S. PTO ☒ Check No. 14682 for \$ 2324-
☐ Amendment After Final Rejection 89/815422 ☐ Deposit Account Order Form
☐ Request for Extension of Time ☒ Drawing 47 Sheet(s)
☐ Provisional Patent Application ☐ Information Disclosure Statement
☒ Application for Patent, including 3/22/01 ☐ PTO Form 1449
114 Pages Specification 43 Claims ☐ Issue Fee Transmittal
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